

PATENT
Attorney Docket No. 188125/ASAHINA

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:

TANAKA et al.

Application No. 09/209,454

Filed: December 11, 1998

For: SYSTEM FOR SELLING CONTACT
LENS

Art Unit: 3622

Examiner: D. Lastra

TRANSMITTAL OF
APPELLANTS' APPEAL BRIEF

Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

In accordance with 37 CFR 1.192, appellants hereby submit Appellants' Brief on Appeal in triplicate.

The items checked below are appropriate:

1. Status of Appellants

This application is on behalf of ☒ other than a small entity or ☐ a small entity.

2. Fee for Filing Brief on Appeal

Pursuant to 37 CFR 1.17(c), the fee for filing the Brief on Appeal is for: ☒ other than a small entity or ☐ a small entity.

Brief Fee Due \$320.00

3. Oral Hearing

☐ Appellants request an oral hearing in accordance with 37 CFR 1.194.

4. Extension of Time

☐ Appellants petition for a one-month extension of time under 37 CFR 1.136, the fee for which is \$110.00.

☒ Appellants believe that no extension of time is required. However, this conditional petition is being made to provide for the possibility that appellants have inadvertently overlooked the need for a petition and fee for extension of time.

Extension fee due with this request: \$

5. Total Fee Due

The total fee due is:

Brief on Appeal Fee	\$320.00
Request for Oral Hearing	\$ 0.00
Extension Fee (if any)	\$ 0.00

Total Fee Due: \$320.00

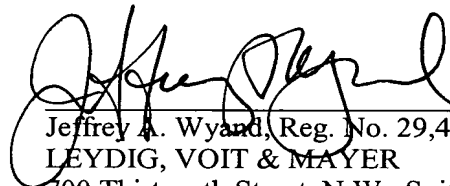
6. Fee Payment

☐ Attached is a check in the sum of \$
☒ Charge Account No. 12-1216 the sum of \$320.00. A duplicate of this transmittal is attached.

7. Fee Deficiency.

☒ If any additional fee is required in connection with this communication, charge Account No. 12-1216. A duplicate copy of this transmittal is attached.

Respectfully submitted,



Jeffrey A. Wyand, Reg. No. 29,458
LEYDIG, VOIT & MAYER
700 Thirteenth Street, N.W., Suite 300
Washington, DC 20005-3960
(202) 737-6770 (telephone)
(202) 737-6776 (facsimile)

Date: February 24, 2003
JAW:ves



PATENT
Attorney Docket No. 188125/ASAHINA

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:

TANAKA et al.

Application No. 09/209,454

Filed: December 11, 1998

For: SYSTEM FOR SELLING CONTACT
LENS

Art Unit: 3622

Examiner: D. Lastra

#21/
Appellants
Appeal
+ fee
3-8-03

APPELLANTS' APPEAL BRIEF

Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

In support of the appeal from the final rejection dated December 23, 2002,
Appellants now submit their Brief.

Real Party In Interest

The patent application that is the subject of this appeal is assigned to Menicon
Co., Ltd., a Japanese business entity that is the real part in interest.

Related Appeals and Interferences

Related Appeals and Interferences

There are no appeals or interferences known to the Appellants, their legal
representative, nor the real party in interest that will directly affect or be directly affected
by or have a bearing on the decision in this appeal.

Status of Claims

As originally filed, this patent application included claims 1-14. In the prosecution of this patent application, which included the filing of a Continued Prosecution Application, claims 1-14 were cancelled and new claims 15-20 were added. After final rejection, claims 15 and 16 were cancelled leaving claims 17-20 pending. None of claims 17-20 is allowed and the final rejection of those claims is appealed. Claims 17-20 appear in the Appendix. As described in the next section, claim 19 appearing in the Appeal Brief assumes the entry of the second amendment after final rejection which has been filed simultaneously with this Brief.

Status of Amendments

An Amendment after Final Rejection canceling claims 15 and 16 was filed simultaneously with the Notice of Appeal. According to a Communication mailed January 9, 2003, the Amendment was entered and claims 15 and 16 were cancelled.

A second amendment after final rejection has been filed simultaneously with this Appeal Brief. The Amendment seeks to correct an error in claim 19 that was not previously cited by the Examiner nor noticed by the Appellants' representative. The form of claim 19 appearing the Appendix assumes entry of the Amendment.

Summary of Invention

The invention is directed to a method of selling and delivering prescription contact lenses including communications between four different parties and delivering of contact lenses between two of the parties. The four parties include the customer, i.e., the ultimate user of the contact lenses, a physician who prescribes contact lenses with the proper optical correction for the customer, a contact lens provider who actually sells prescription contact lenses, and a selling agent who delivers the contact lenses to the customer. Initially, the customer consults with a physician, an ophthalmologist, for example, or another person legally authorized to prescribe contact lenses. That physician or his organization prepares customer identification information including an address and diagnostic data pertaining to the customer. According to the first paragraph of claim 17, that customer information, address, and diagnostic data for a particular customer is

transferred to a contact lens provider through a communication network. The contact lens provider may be a manufacturer or wholesaler who maintains an inventory of contact lenses and sells contact lenses.

In accordance with the method of claim 17, a registration number is assigned to the customer and stored in relationship to the customer identification, which includes the customer address, and diagnostic data that is transferred to the contact lens provider. The customer address is particularly important because it is used to associate a selling agent who actually delivers contact lenses to the ultimate consumer with the customer. In the next step of the process, the registration number assigned for a particular customer and data concerning a selling agent closest in geographical relationship to the customer, based upon the customer address data, is supplied to the customer by the contact lens provider. In other words, the customer is directed to the selling agent from whom he can procure contact lenses and who is closest to the customer geographically. The process further includes delivering a contact lens by the selling agent so identified to the customer. In turn, the selling agent transfers delivery data to the contact lens provider who directed the customer to the selling agent. The flow charts of Figures 6 and 10 of the patent application illustrate a method and communication arrangement within the scope of claim 17.

In the method defined by the dependent claim 18, the contact lens provider, not the selling agent, notifies a customer of an approaching deadline for replacing the contact lenses. This notification is given based upon the well known limited lifetime of disposable contact lenses to stimulate sales through the selling agent. Claim 18 is supported in the patent application by, among other passages, page 21 at lines 5-19.

The method according to claim 19 further provides, in conjunction with the notification regarding the deadline, an arrangement in which the customer makes a regular monthly payment so that new contact lenses are periodically supplied in exchange for old contact lenses. This process not only stimulates sales but also protects the customer by avoiding use of disposable contact lenses beyond the term recommended by the manufacturer. Claim 19 is supported by the patent application in the passages at page 13, lines 16-25 and page 21, line 20 through page 22, line 2.

Claim 20 specifies a process for stimulating the sale of articles associated with contact lens use. The contact lens provider periodically offers contact lens care articles through the communication network upon which the numerous communications specified

in claim 17 take place, such as the internet. Claim 20 is supported particularly in the flow chart of Figure 9.

Issues

1. Are either of claims 17 and 20 unpatentable over Schlueter Jr. et al. (U.S. Patent 5,974,124, hereinafter Schlueter) in view of Eggleston et al. (U.S. Patent 6,061,660, hereinafter Eggleston)?

2. Are either of claims 18 and 19 unpatentable over Schlueter in view of Eggleston and further in view of Dziabo, Jr. et al. (U.S. Patent 5,213,760, hereinafter Dziabo)?

Grouping of Claims

Claims 17 and 20 stand or fall together. If the rejection of claim 17 is reversed, then there is no necessity of considering the final rejection of claims 18 and 19.

Claim 18 stands or falls by itself.

Claim 19 stands or falls by itself.

Argument

Claims 17 and 20 Are Not Obvious

Neither of claims 17 and 20 can be obvious over Schlueter in view of Eggleston because those two patents only tenuously relate to the individual process steps of claim 17. Schlueter generally relates to remote collection of medical information and Eggleston concerns a method of delivering prizes to contest winners. Taken together, these publications cannot suggest the claimed method of selling and delivering contact lenses involving a physician diagnosis, communication with the contact lens provider, identifying the selling agent closest to the customer, and delivery of contact lenses according to the physician's prescription by the selling agent to the customer.

Schlueter is directed to a method of collecting raw data, such as blood pressure or blood sugar, from patients who must be continually monitored and without the necessity of a medical practitioner attending the patient. Either the patient collects the information through self-testing or is tested at home or a laboratory by a medical assistant. No matter

how the information concerning the patient's condition is collected, the information is transmitted electronically to a central data base, for example, over the internet. This compilation of medical diagnostic information at a central location permits a physician to analyze the information so that any change in medical treatment or any new medical treatment that may be required can be supplied. There is no description in Schlueter that the data collected pertains to ophthalmic needs, such as the supplying of contact lenses. In fact, there is nothing in Schlueter about selling contact lenses or other prescribed or over-the-counter medical articles. The only relevance of Schlueter to the claimed invention is that Schlueter describes constructing a data record for patients containing various patient identification and diagnostic information. Schlueter discloses nothing concerning communicating with a supplier of any goods, medical or otherwise. Thus, at best, Schlueter may supply disclosure meeting the terms of the second paragraph of claim 17.

Eggleston is concerned with incentive programs, i.e., supplying prizes in response to contests or rewards for outstanding performance. The persons participating in these contests are located over a wide geographical area making delivery of their prizes and awards from a central location somewhat expensive, complicated, and delayed. Thus, Eggleston provides a correlation between locations of various suppliers of goods that are awarded as prizes and the locations of prize winners. A winner who is notified of a prize award thus can be given the name of a nearby merchant from whom the prize can be obtained.

The apparent relationship between Eggleston and claim 17 concerns the third through fifth paragraphs of claim 17. In claim 17, a customer is notified of the contact lens selling agent who is closest to the customer. In Eggleston, the prize winner is notified of the nearest merchant delivering prizes. To the extent a merchant in the Eggleston method supplies a contest prize, there may be a tenuous parallel between the delivery of a prize from a merchant located near a prize winner to the delivery of purchased contact lenses by a selling agent to a customer. Eggleston provides for a confirmation of delivery of a prize so that the merchant can be reimbursed for the cost of the prize. Presumably, the Examiner is asserting that the step in the final paragraph of claim 17 would be considered to correspond to this prize delivery confirmation.

Notwithstanding the similarity of one step in claim 17 to Schlueter and the possible similarity between three steps of claim 17 to Eggleston, there is no suggestion in

the prior art for any modification of Schlueter by Eggleston. Moreover, the combination cannot supply all of the elements of claim 17.

The invention, as defined by claim 17, concerns a system in which a medical diagnosis is made that inherently requires the supply of prescription medical goods. Further, in the method of claim 17, the physician has a direct connection and relationship to the supplier of the prescription medical goods, i.e., contact lenses. There is no connection between a physician and a supplier of any goods anywhere within Schlueter. In applying Schlueter and Eggleston, the Examiner never asserted that either reference provides such a connection between a physician and a supplier of goods. Rather, that limitation and other limitations of claim 17 clearly missing from the prior art seem to have been dismissed based upon the outmoded doctrine of "printed matter" that was actually refuted in the two Federal Circuit cases cited by the Examiner, In re Gulack, 217 USPQ 401 (Fed. Cir. 1983) and In re Lowry, 32 USPQ2d 1031 (Fed. Cir. 1994).

Eggleston, concerning prize winning unrelated to any kind of medical diagnosis or the supplying of prescription medical goods, is so remote from Schlueter that one of skill in the art would never look to Eggleston to modify anything in Schlueter. The potential customers in Eggleston are not customers at all but contest winners who collect prizes from local merchants, not contact lens buyers who need continual monitoring and supplying of contact lenses. No explanation is provided in the final rejection as to how one of skill in the art would make the leap from Schlueter to Eggleston without knowledge of the invention. In more conventional terms, no motivation has been supplied for the hypothetical modification of Schlueter with Eggleston. In other words, even if Schlueter and Eggleston included all of the elements of claim 17, *prima facie* obviousness has still not been established because motivation for the modification of Schlueter with Eggleston has not been supplied. Only the benefit of knowledge of the invention could even lead to Eggleston as a potential basis for modifying Schlueter because their contexts are so entirely different. On this ground alone, the rejection of claims 17 and 20 must be reversed.

The application of hindsight in the final rejection is apparent from the Official Action itself. "It would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that although Eggleston does not mention contact lenses, its invention would apply to any kind of product or incentive." It stretches the imagination beyond limit to suggest that a prescription item, such as a contact lens, would ever be considered an incentive for improved performance or awarded as a prize. The

rejection of claim 17 lacks the support required to establish obviousness, regardless of the technology to which the invention pertains. For that additional reason, the rejection of claim 17 and of its dependent claim 20, must be reversed.

Even if Eggleston could be applied to modify Schlueter, the modification would not produce the invention of claim 17. There is nothing in either Schlueter or Eggleston that can be compared to the first paragraph of claim 17. Eggleston does not concern physicians or medical practitioners of any kind. The contact lens provider is not comparable to the merchant in Eggleston, because the selling agent is considered equivalent to the merchant. The contact lens provider of claim 17 is considered, in the rejection, to correspond to the contest operator in Eggleston. The physician in Schlueter may correspond with other medical treatment providers. However, neither Schlueter nor Eggleston provides, considering the other correspondences, anything like the physician communication with a prescription goods supplier. There are not enough communication links to go around in the proposed modification of Schlueter with Eggleston. Therefore, even if the modification is made, at least one claim element is missing, demonstrating that *prima facie* obviousness has not been established. On this additional ground, the rejection of claims 17 and 20 must be reversed.

Upon the reversal of the rejection of claim 17, there is no necessity of considering, independently, the patentability of claims 18 and 19.

Dziabo Does Not Make Claim 18 Obvious

The method of claim 18 includes supplying a reminder from the contact lens provider to the customer of the approach of a deadline for replacing disposable contact lenses with new contact lenses due to normal wear and the limited lifetime of the lenses. This limitation is allegedly supplied by Dziabo, the only reference applied that has any relationship to contact lenses. Even at the outset the rejection is questionable. Without knowledge of the invention, one of skill in the art would not rely upon Dziabo as a tertiary reference to modify references, i.e., Schlueter and Eggleston, that have no relationship to each other and that cannot be properly combined.

The only citation to Dziabo in the rejection was to its column 1 which describes the limited lifetime of disposable contact lenses. Dziabo describes a contact lens that includes a tinting material that is gradually leached from the lenses as they are repeatedly cleansed in a disinfectant. The changing intensity of the tint warns the contact lens user that the lenses are approaching the end of their lifetime and should be replaced. This

chemical notification depends entirely upon the user of the lenses observing the change in the color of the contact lenses and is not an external reminder from a third party, as in the limitation of claim 18.

Claim 18 specifies that the notice of an approaching end of the permissible use period of contact lenses is delivered through a communication network from a third party, the contact lens provider. This kind of nagging reminder is totally different in character from the observation by the contact lens user, presumably when the lenses are not in place and the vision of the user is impaired, of the change in tint taught by Dziabo.

Appellants agree that Dziabo states the problem solved by the method of claim 18 and that Dziabo provides a solution to notifying a user of expiration of the lifetime of contact lenses. However, stating the problem and providing a solution to the problem, unrelated to the solution of claim 18, does not suggest the solution of claim 18.

Dziabo's warning is based on the number of cleanings of a lens and does not correlate with the passage of time, the basis of the notification given according to the method of claim 18. Arguments as to whether Dziabo's warning, if detected, is more reliable, demonstrate the total difference between the two warnings and that Dziabo never suggests providing a warning through a communication network, as in claim 18. Dziabo does not come close to supplying the limitation of claim 18 and could not establish *prima facie* obviousness of that claim even if claim 17 were obvious. The rejection of claim 18 must be reversed.

Claim 19 Cannot Be Obvious

Claim 19 depends from claim 18 and further provides for offering to a customer new contact lenses in exchange for old contact lenses and a regular monthly payment by the customer. The sole basis for the final rejection of claim 19 is that "it would be a business decision to offer new contact lenses as a substitute for old ones by charging a monthly fee".

If there is a factual basis for the rejection of claim 19, the Examiner has failed to supply it. Appellants agree that it is well known that, as demonstrated by Dziabo, disposable contact lenses have a limited lifetime. However, there is no basis in Dziabo nor any prior art relied upon by the Examiner for asserting that anyone trades in old contact lenses for new contact lenses, rather than simply disposing of the expired contact lenses. Further, the assertion that "it would be a business decision" to make the exchange and charge a monthly fee in accordance with the exchange is conjuring, not the factual

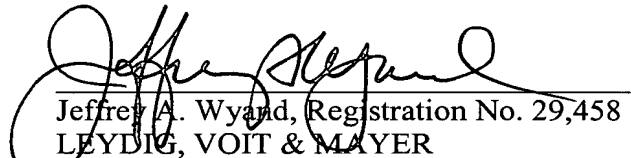
demonstration needed to establish obviousness. In re Fine, 5 USPQ2d 1596 (Fed. Cir. 1988).

The limitation of claim 19 is simply not found anywhere in the prior art much less in a way that would suggest modification of its parent claims 18 and 17. Accordingly, the rejection of claim 19 cannot be sustained.

Summary

Prima facie obviousness has not been demonstrated with regard to any of the claims on appeal. *Prima facie* obviousness has not been established because at least one limitation of each claim is missing from the prior art and there has been no proper demonstration of motivation for combining the patents relied upon in the prior art rejections. Further, the non-prior art rejection of claim 19 is legally deficient. Reversal of the rejections of claims 17-20 is proper and earnestly solicited.

Respectfully submitted,


Jeffrey A. Wyand, Registration No. 29,458
LEYDIG, VOIT & MAYER
700 Thirteenth Street, N.W., Suite 300
Washington, DC 20005-3960
(202) 737-6770 (telephone)
(202) 737-6776 (facsimile)

Date: February 24, 2003
JAW:ves

APPENDIX

17. A method of selling prescription contact lenses comprising:
 - transferring customer identification, address, and diagnostic data pertaining to a customer from a physician to a contact lens provider through a communication network;
 - assigning a registration number to the customer and storing the registration number assigned in relationship with the customer identification and diagnostic data transferred to the provider;
 - providing the registration number assigned and selling agent data for a selling agent closest in geographical relation to the customer based on the customer address data, from the contact lens provider to the customer, through the communication network;
 - delivering a contact lens from the selling agent to the customer; and
 - transferring delivery data from the selling agent to the contact lens provider through the communication network.
18. The method of Claim 17, including delivering notification of an approaching deadline to replace the contact lens from the contact lens provider to the customer through the communication network.
19. The method of Claim 18, including offering new contact lenses to the customer in exchange for old contact lenses and a monthly payment by the customer.
20. The method of Claim 17, including periodically offering for sale contact lens care articles by the contact lens provider to the customer through the communication network.